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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/550,622

08/03/2006

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EXAMINER

YU, GINA C

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/550,622	Applicant(s) IVANOVA ET AL.	
	Examiner GINA C. YU	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 8, 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7,8,10,11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 7, 8, 10, 11, 13, 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of amendment filed on November 8, 2007.

Claims 1, 3-5, 7, 8, 10, 12, 13, and 14 are pending. Claim rejections made under 35 U.S.C. § 112, second paragraph, as indicated in the previous Office action, are withdrawn in view of the claim amendment made by applicant. Claim rejections made under 35 U.S.C. § 102 and obviousness double patenting rejections are withdrawn and modified to address the claim amendment. New rejections are made as discussed below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 14 recites a hair treatment composition according to claim 1 in which silicone-based solvents are absent. While applicant states that specification p. 10, lines 19-20 supports the new claim, examiner respectfully disagrees. The particular disclosure on p. 10 states, "other silicone-based solvents can additionally be present, but it is preferred if they are absent".

According to applicant's own disclosure, the silicone PSA emulsion of instant invention contains polydiorganosiloxanes as described in pp. 5-9 of the specification, and the specification p. 10, lines 19-20 seems to merely support a PSA emulsion having polydiorganosiloxanes and no other silicone-based solvents. The present scope of claim 14, however, excludes even polydiorganosiloxane, which is not supported by applicant's original disclosure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-5, 7, 8, 10, 12, 13, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "in the form of a leave-on hair styling product", which renders the claim vague and indefinite because what determines whether a product is a leave-on or rinse-off depends on the intended use of the product, rather than a specific form of the product. For example a composition in the form of cream can be used either as a rinse-off or leave-on product depending on the intended use. See *Cosmetic and Toiletry Formulations*, pp. 392-3. Although applicant has stated in the specification that the these product forms include mousse, gel, lotion, cream, spray and tonics, it is not clear whether the limitation requires the instant composition to be in this specific physical forms, or any form of composition which used as a leave-on product will meet this limitation.

The remaining claims are rejected as they depend on the indefinite base claims.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3-5, 7, 8, 10, 11, 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Clapp (US 6887859).

Clapp teaches topical liquid compositions comprising Bio-PSA, 40 % silicone pressure sensitive adhesive in isododecane. See Tables 3 and 5; instant claims 1, 4, 5, 10. The reference suggests formulating the compositions into aerosol, which necessarily contains propellants, and to use the produce either a leave-on or rinse-off product. See col. 3, lines 49 – 67. See instant claims 7, 8. The use of the prior art invention for hair care is also taught therein. Addition of hair conditioning agent, such as emollient, and surfactants are also taught. See col. 11, lines 54 – 65; instant claim 1. Since the final composition of the silicone-PSA/isododecane solvent is made in the form aqueous dispersion, there seems to be no distinction in the final prior art product and the instant invention.

Claims 1, 3-5, 10, 11, 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Dhamdhare et al. (US 6787130 B2).

Dhamdhare teaches an aqueous hair treatment composition comprising at least one silicone PSA and at least one material selecting from a hair conditioning agent, a hair cleansing agent, and an agent for hair care suspension. See abstract. The reference teaches that silicone PSA emulsion is

prepared by emulsifying the silicone with a volatile silicone fluid in water using one or more emulsifiers. See col. 4, line 64 – col. 5, line 10. Table 1, Examples 2-4 discloses compositions comprising DC 5-7300 (40 % silicone PSA emulsion), fatty alcohols and silicone fluids (hair conditioning agents). See instant claims 1-5, 9, 10. The reference teaches that the composition is used as a hair styling aid. See instant claim 11. The reference teaches that the use of PSA in the composition renders styling benefits without sticky feel. See col. 2, lines 54 – 61. See instant claims 11 and 13.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-5, 7, 8, 10, 11, 13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/550623.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to compositions comprising a silicone pressure sensitive adhesive wherein the pressure sensitive adhesive is in the form of an emulsion. The limitations of the dependent claims also overlap.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 3-5, 7, 8, 10, 11, 13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Pat. No. Dhamdhare et al. (US 6787130 B2).

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to compositions comprising a silicone pressure sensitive adhesive wherein the pressure sensitive adhesive is in the form of an emulsion. The limitations of the dependent claims also overlap.

Response to Arguments

Applicant's arguments filed on November 8, 2007 have been fully considered but they are not persuasive.

Claim rejection made in view of Clapp

Applicant's statement that Clapp fails to teach hair styling product is incorrect; through out the specification of the patent, the prior art discusses the use of the prior art product on hair. Furthermore, how the present invention is used as a leave-on hair styling product denotes an intended use of the claimed subject matter and no patentable weight should be given to the preamble of the claim.

Applicant asserts that Clapp teaches not to apply its compositions to the head or neck in col. 14, lines 18-20, however, that passage is taken out of context. The disclosure specifically refers to a composition which is formulated to absorb sebum and/or sweat, and the preceding paragraph in the same column, lines 1-12 discusses leave-on products for hair application.

Nonetheless, the present invention is a composition per se, where the intended use of the composition is a mere preamble and not a claim limitation. Whether the topical liquid composition in Table 5 is used as a hair styling product, the disclosure of the prior art cosmetic composition which otherwise meets all limitations of the instant claims. Applicant asserts that the prior art PSA additive "is for an entirely different use", but applicant's intended use of the PSA adhesive composition will be not be given patentable weight.

Claim rejection made in view of Dhamdhere

Applicant asserts that the claim amendment overcomes rejections made in view of the Dhamdhere reference, however, does not specifically point out how the amendment overcomes the rejection.

Obviousness double patenting rejections

Applicant argues that the claim amendment overcomes obviousness double patenting rejections, however, does not specifically point out how the amendment overcomes the rejections.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gina C. Yu/
Patent Examiner